Application and Scope of Order No. 2010

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When an application is filed which, in the opinion of the Examiner is a division of, a continuation of, or a substitution for a previously filed application, but which contains no reference to such prior application, the Examiner will make a proper reference to the prior application in the record and an appropriate entry upon the face of the file wrapper.

This is the substance of Order No. 2010, October 18, 1912, as modified by Order No. 2071, September 19, 1913.

In Order 2071 divisional applications are not mentioned specifically, but as they are merely a species of continuing applications the scope of the order is the same as Order 2010.

It is not difficult to recognize a divisional application.

The rules of practice disclose clearly the nature of a divisional application, but they do not define substitute applications, and continuing applications. Such information must be drawn from the decisions.

These questions may present themselves on any Examiner's desk, any day, and each one should be prepared to take the proper action, and make the proper endorsement on the file.

The requirement is so just, it is surprising to realize it is of such recent origin.

It is the simplest way by which the complete records of the prosecution of such applications can be lawfully thrown open to the public after patents issue thereon.

However, from the organization of the Patent Office until June, 1903, it was possible for an applicant to prosecute an application until it was ready for issue or allowed, make and file a clean copy of the contents of the patentable file, then abandon the parent application and receive a patent from this office which, as far as the records open to the public showed, was passed to issue without a criticism, or the citation of a reference.

The great injustice to the public of such a proceeding was generally recognized by the examining corps, commented upon frequently and greatly deplored, but there was no authority in the rules or in the decisions for preventing such an abuse.

These tactics were employed so frequently that, instead of being the exception, they became the settled practice of some attorneys and were resorted to every time they had a client who was willing to pay another filing fee, and the expense of preparing the clean application.

The circumstances which resulted in establishing the present practice arose in this manner:

Lewis and Unger filed an application claiming the invention of a process for cutting steel plates. Some of the claims of that application were finally rejected and, on appeal to the Board of Examiners-in-Chief, the final rejection was sustained. They then filed two new applications disclosing and claiming the same invention. Some of the claims in these two applications were finally rejected, but, upon appeal to the Board, the rejection was overruled and the claims were allowed. The Examiners-in-Chief suggested that all the claims be incorporated into a single application. Lewis and Unger adopted the Board's suggestion. All the claims were placed in a single case, and that case was passed to issue. Thereupon, after notice of allowance the objectionable practice of filing a new and clean record was resorted to, and a new application was filed which was a literal copy of the allowed case, but made no reference to the prior applications and, of course, eliminated all amendments, rejections, appeals, consolidations, etc., and, on the day after *that* application was filed, a formal abandonment of the allowed application reached the office. It was as follows:

> "We hereby abandon the prosecution of the above entitled application, without abandoning the invention described and claimed therein, as we are, today, forwarding to the Patent Office, for filing, another application covering substantially the same subject-matter."

It is apparent that, from the filing of the first or parent application to the issuing of the patent on the fourth application there would have been a continuous unbroken line of live applications, describing and claiming the same invention, securing to the patentees all the benefits which accrued from the filing date of the parent application, which should be open to public inspection, but all of which would have been concealed excepting the last one—the clean copy of the previously allowed application—if the old and vicious practice of getting a clean record, as it was called, had not been stopped.

This was such an extreme example of withholding information most valuable and necessary and to which, in consideration for the grant of the patent, every one interested or concerned was entitled, that it was submitted to the Commissioner of Patents by the Primary Examiner for instructions as to the action which should be taken. The question being: Shall the application be allowed without some reference to prior abandoned applications for which it was substituted?

June 24, 1913, Commissioner Allen handed down the decision which is the foundation of the present practice.

Briefly stated the reasons and conclusions in Ex parte Lewis and Unger, C. D., 1903-303 are:

The claims were allowed by the Board of Examiners-in-Chief. There is nothing in the new application to show that fact. If the case be passed to issue without a reference to the prior cases it would appear that it was allowed without the citation of a single reference. The date of filing printed in the patent would be misleading because the last application was a continuation of the prior applications. The language of the letter of abandonment is such that it is clear applicants intend to retain all the benefits resulting from the prior applications but they wish to conceal those applications from the public. This would mislead and deceive the public as to the record date to which the patentees were entitled. The office can not knowingly permit the patents issued to contain a false suggestion of fact which may mislead the public. Neither should the office conceal from the public the proceedings

which lead to the grant of a patent. All such proceedings should be open to the public. *It is held* that the present application should not be allowed without a reference to the prior applications and that there should be endorsed upon the file wrapper a statement that it is a continuation of those applications.

In January, 1905, Ex parte Taylor, Jr., C. D., 1905-45, was decided.

This was a case where an application was allowed and forfeited and a new application was filed for the same thing.

It was held that notice of the first case should be included in the second.

In April, 1905, Ex parte Britt, C. D., 1905-156, was decided.

In this case, an application was prosecuted to allowance, but was allowed to become abandoned, and thereafter a new application was filed for the same invention, and containing the allowed claims. It was held that there should be a reference in the new application to the abandoned application.

Give careful consideration to this case. The first application was abandoned—totally dead, yet a reference to it was required in a subsequently filed application by the same applicant for the same invention.

This ruling was probably based on the holding of the Supreme Court of the United States that if a party choose to withdraw his application for a patent, and file a new application for the same subject-matter the two applications are to be considered parts of the same transaction. Godfrey *vs.* Eames, 1 Wall., 317.

These three decisions established the practice upon which Order No. 2010 was based.

To correctly apply the order, we must be able to tell when applications are divisions of, continuations of, or substitutes for previously filed applications, because when an application is a continuation of or a substitute for an earlier application the record made in the parent application should be as much open to the inspection of the public as the record in the patented file. *In re* Doman, C. D., 1905-101.

Taking up the question of divisional applications, which are a species of continuing applications:

It is fundamental that a proper divisional application does and can contain only matter carved out of the original case. *Ex parte* Henry, C. D., 1893-88, 64 O. G., 299; *Ex parte* Kruse, C. D., 1910-119.

The addition of unessential details, such as braces for a frame, does not affect the status of an application as far as the question of its being properly divisional is concerned. Phelps *vs.* Hardy *vs.* Gatman & Stern, 77 O. G., 631, C. D., 1896, 70.

Nor does a mere enlargement or extension of a certain feature, whereby no additional function or capability is given the apparatus, prevent a case from being a divisional application. *Ex parte* Kayser, C. D., 1898-65; 83 O. G., 915.

But where an application contains matter divided out of a prior application and also contains other matter it is not a divisional application. *Ex parte* Hicks, C. D., 1903, 148; 104 O. G., 309.

In fact where there is any departure from the disclosure of the alleged parent case, the application can not be referred to as a division thereof. *Ex parte* Kruse, C. D., 1910-119; 157 O. G., 208.

Turning now to continuing applications:

For an application to be a continuation of another such as to warrant giving to the second the benefit of the first filing date, the proceedings relating to the two must be merged into a single proceeding. There must be a connection between the two which is warranted by law. Sarfert *vs.* Meyer, C. D., 1902-30.

The rule of continuity rests broadly upon the subject-matter of the invention and not upon the specific embodiment. Latterhead *vs.* Hanson, C. D., 1904-646.

Hence an application may be a continuation of an older application when the two have common subject-matter even though the later application contains matter which is a departure from that shown and described in the original application. *Ex parte* Kruse, C. D., 1910-119; Lorimer et al. *vs.* Keith et al., 205 O. G., 1555; Godfrey *vs.* Eames, 1 Wall., 317; Cain *vs.* Park, C. D., 1899-278; Latterhead *vs.* Hanson, C. D., 1904-646;

Lotz *vs.* Kenney, C. D., 1908-467; Von Recklinghausen *vs.* Dempster, C. D., 1910-365; Field *vs.* Colman, C. D., 1913-450; *Ex parte* Luten, C. D., 1913-165.

An application filed to take the place of another application subsequently abandoned is a continuation of the parent application. Lewis and Unger, C. D., 1903-303. *In re* Doman, C. D., 1905-101; *In re* Vacuum Specialty Co., C. D., 1909-88.

So is a new application filed, by an executor, during the life of the parent application. *Ex parte* Smith, C. D., 1888-24.

But an application disclosing and claiming subject-matter disclosed in a patent granted prior to the filing of such application can not be considered as a continuance of the prior application, since after the application has eventuated into a patent there is nothing left pending before the Patent Office upon which it could act or to which the later application could attach. Wainwright *vs.* Parker, C. D., 1909-379; *In re* Spitteler and Krische, C. D., 1908-374.

Neither can a second application be a continuation of a first or earlier application by the same inventor unless it contains the same invention. Green *vs.* Hall *vs.* Siemens *vs.* Field, C. D., 1889-110; *Ex parte* Luten, C. D., 1913-165; Field *vs.* Colman, C. D., 1913-450.

Likewise applications by joint applicants can not be continuations of applications filed by sole applicants, and vice versa; because the applicants in the two cases are different entities. Arnold *vs.* Vaughn, and Cabot *vs.* Arnold and Fisher, C. D., 1904-78.

Furthermore when an application is abandoned for failure to prosecute or otherwise, a second application thereafter for the same subject-matter is not a continuing application. Hien *vs.* Pungs, C. D., 1894-92. Carty *vs.* Kellogg, C. D., 1895, 83; *Ex parte* Britt, C. D., 1905-156.

The decision of the Supreme Court of the United States in Smith *vs.* The Goodyear Dental Vulcanite Co., C. D., 1877-171 does not establish a doctrine contrary to the last statement.

In that case Smith filed an application in 1855, prosecuted it until some time in 1856, and then did nothing until 1864, eight years afterwards, when he filed

a new application for the same invention, and the court held the second application was a continuation of the first. The explanation is:

Abandonment for failure to prosecute was not enacted as a part of the patent law until 1870. Consolidated Patent Act of 1870, sec. 32, 16 Statutes at Large, p. 198; R. S., 4894.

In the order under consideration three species of applications are named—divisional, continuous, and substitute.

It is believed that the attention already given to the first two is quite sufficient to enable one to establish their identity easily and certainly. However, the foregoing statements based on various decisions bearing on the subjects are sufficient authority for the following definitions for the terms divisional application and continuous application.

A divisional application is an application carved out of a prior application, which does not vary materially from the disclosure in the parent application. It must be filed by the person who filed the parent application or by his legal representative while the parent application is pending.

A continuous application is an application filed subsequently to another application, while the prior application is pending, disclosing all or a part of the subject-matter of the prior application and containing a claim to subject-matter common to both applications, both applications being filed by the same inventor or his legal representative. Putting it in a simpler way a continuous application is one which is entitled to the filing date of a prior application for a constructive reduction to practice.

But when the subject of substitute applications is taken up for consideration no line of decisions giving examples and definitions is found.

Divisional applications and continuing applications have been called substitute applications. In fact the term appears to be loosely applied to any application which takes the place of a prior application. Ex parte Lewis and Unger, C. D., 1903-303; Ex parte Taylor, Jr. C. D., 1905-45; In re Doman, C. D., 1905-101.

As far as now appears, all cases in which endorsements on the file wrappers are necessary to carry out the spirit and the letter of Order 2010 can be classified as divisional applications or continuing applications excepting the single species represented by *Ex parte* Britt—cases in which a period of abandonment intervenes between the filing of the first application, and the filing of the second application. During such period of abandonment no live case is before the office.

Doubtless the Commissioner had in mind this type of cases when he introduced the word "substitute."

Therefore, all applications affected by Order No. 2010, which are neither divisional applications nor continuing applications, should be termed substitute applications in the endorsement upon the file wrapper.

This being the case, the conclusion necessarily follows that Order No. 2010 is comprehensive enough to cover every instance where the public is entitled to examine the complete record of the proceedings in the Patent Office leading to the issuing of a patent when such record is not all in the patented file; and that one or another of the three terms—divisional, continuous, and substitute—will clearly designate every case in which the public has such a right.